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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/672,435	09/28/2000	John Kenyon Gerken III	RAL9-2000-0034US1	8160
25299	7590	12/03/2003	EXAMINER	
IBM CORPORATION PO BOX 12195 DEPT 9CCA, BLDG 002 RESEARCH TRIANGLE PARK, NC 27709			MCCLELLAN, JAMES S	
			ART UNIT	PAPER NUMBER
			3627	

DATE MAILED: 12/03/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/672,435

Applicant(s)

GERKEN ET AL.

Examiner

James S McClellan

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 October 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-57 is/are pending in the application.
- 4a) Of the above claim(s) 46-57 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8, 11, 15-30, 33 and 37-45 is/are rejected.
- 7) ☒ Claim(s) 9, 10, 12-14, 31, 32, and 34-36 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Amendment

1. Applicant's submittal of an amendment was entered on October 20, 2003, wherein:
 - claims 1-57 are pending;
 - claims 46-57 have been withdrawn; and
 - claims 1 and 24 have been amended.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1-5, 8, 11, 24-28, and 33 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 5,010,485 (Bigari).

In regards to independent **claim 1**, Bigari discloses a method of accelerating sales transactions of customers in a retail store (see column 3, lines 12-15), comprising the acts of: reading a customer payment card number (via card reader 24) at a customer checkout accelerator; determining a preapproval amount for the sales transaction (see column 7, lines 21-23); displaying the preapproval sales transaction amount to the customer on the checkout accelerator for acceptance (via display 28, see column 7, lines 23-26); transmitting the preapproval amount to an external card services system for approval (see column 7, lines 49-62); and storing the approval amount in a preapproval cache (it is inherent that the information is

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stored in cache) at a point of sales terminal (via communications line 33) for use in completing the sales transaction; **[claim 2]** transmitting the preapproval amount from the customer checkout accelerator to a store controller (12, via transmitter/receiver 16); **[claim 3]** placing an entry in a preapproval database (26) if the external card services system approves the transaction amount; **[claim 4]** notifying a point of sales terminal of the approval amount (via communication line 33 or voucher reader 34); **[claim 5]** determining if the payment card is one or more of credit card (see charge card reader 24), debit card, a customer loyalty card, an electronic/Internet wallet, or an electronic gift certificate; **[claim 8]** manually entering a specific preapproval amount by the customer (see column 7, lines 21-23); and **[claim 11]** printing a sales transaction receipt and a credit or debit voucher (see column 8, lines 49-52).

In regards to independent **claim 24**; Bigari discloses a computer readable medium containing a computer program product for accelerating sales transactions of customers in a retails that is programmed to complete the steps of claim 1 as described above in detail. Bigari discloses the limitations of **claims 24-28 and 33** as described above in detail for similar claims 1-5, 8, and 11.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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5. Claims 6, 7, 29, and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bigari in view of *Official Notice*.

In regards to **claims 6, 7, 29, and 30**, Bigari fails to explicitly disclose alternative methods of establishing a preapproval amount. The examiner takes Official Notice that it is old and well known at the time the invention was made to utilize historical data including specific customer information or storewide information to determine preapproval amounts.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Bigari with the alternative steps of determining preapproval amounts as is well known in the art, because using historical data provides an accurate estimate of the required preapproval amount, wherein reducing the chance of requesting time consuming reauthorizations.

U.S. Patent No. 6,611,811 (Deaton et al.) is relied upon as factual evidence that is was old and well known at the time of the invention to utilize historical data to determine credit approval (as an example, see column 73).

6. Claims 15-23 and 37-45 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bigari in view of U.S. Patent No. 5,595,264 (Trotta, Jr.).

In regards to **claims 15-23 and 37-45**, Bigari fails to disclose displaying a selection of promotional merchandise that can be added to the sales transactions and updating a vendor-based tracking database to bill the vendor, wherein a selection of additional categories of items is displayed based on customer preferences.

Trotta, Jr. teaches the use of displaying a selection of promotional merchandise that can be added to the sales transactions (see column 7, lines 9-20) and updating a vendor-based

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tracking database to bill the vendor (see column 7, lines 5-9), wherein a selection of additional categories of items is displayed based on customer preferences (see column 7, lines 3-5, "spending habits").

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Bigari with promotional display as taught by Trotta, Jr., because the promotional displays valuable shopper specific marketing data which can be sold to manufacturers to subsidize the cost of the technology (see column 7, lines 4-6).

In regards to claims 15, 19, 37, and 41, it is noted that Applicant failed to positively claim that the promotional merchandise is made available through one or more Internet web sites. The claims use the functional language "can be made available". Clearly, at the time the invention was made, the promotional merchandise could have been made available via a hyperlink to an Internet website.

Allowable Subject Matter

7. Claims 9, 10, 12-14, 31, 32, and 34-36 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Arguments

8. Applicant's arguments filed November 25, 2003 have been fully considered but they are not entirely persuasive.

On pages 18-19, Applicant's remarks and amendments have overcome the

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objections to the drawings, objections to the specification, and rejections under 35 U.S.C. § 112.

The objections to the drawings, objections to the specification, and rejections under 35 U.S.C. § 112 are withdrawn.

On page 20, Applicant summarizes features of Bigari. Applicant's summary of Bigari is acknowledged.

On page 21, first full paragraph, Applicant argues that Bigari fails to disclose storing the approval amount in a preapproval cache at a point of sales terminal for use in completing the sales transaction. The Examiner respectfully disagrees. Bigari discloses transferring preapproval information from microprocessor (12) to cash register (32) via voucher read (34) or communication line (33). During the processing of a transaction at the POS, the preapproval amount is read from a voucher by a voucher reader (34). The voucher reader (34) transmits the preapproval amount to the cash register processor that inherently stores that information in cache while determining the final transaction amount (see the process of Figure 6; see column 10, lines 11-40).

On page 22, first full paragraph, Applicant argues that Bigari fails to disclose transmitting the preapproval amount from the customer checkout accelerator to a store controller as required by claim 2. To better clarify the rejection, the Examiner notes that the Bigari's microprocessor (12) is comparable to Applicant's store controller. The microprocessor stores data in memory 26 and is in communication with cash registers (32; see paragraph bridging columns 9-10).

On page 22, second full paragraph, Applicant argues that Bigari fails to disclose placing an entry in a preapproval database if the external card services system approves the transaction

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amount. The Examiner respectfully disagrees. Memory 26 of Bigari is a preapproval database used to store a preapproval amount (see column 8, lines 6-22).

On page 22, final paragraph, Applicant argues that Bigari fails to disclose notifying a point of sales terminal of the approval amount. The Examiner respectfully disagrees. The POS terminal (32) is notified via voucher reader (34) of the approval amount (see column 9, lines 65-66).

On page 23, first and second full paragraphs, Applicant argues that Bigari fails to disclose scanning the customer payment card at a point of sales terminal as required by claim 9. The Examiner agrees that Bigari fails to disclose scanning the *customer payment card* at the POS terminal. Bigari discloses scanning a voucher, which may be in the form of a card, at the POS terminal.

On page 24, first and second full paragraphs, Applicant argues that Bigari fails to disclose updating a preapproval database with the actual sales transaction amount. The Examiner respectfully disagrees. In column 10, lines 32-50, Bigari discloses updating the preapproval database (26) with actual sales transaction amount. However, since claim 10 depend from claim 9, the rejection is withdrawn.

On page 25, first paragraph, Applicant argues that Bigari fails to disclose printing a sales transaction receipt and a credit or debit voucher. The Examiner respectfully disagrees. In column 8, lines 49-52, wherein the customer is given an updated receipt B.

On page 25, second paragraph, Applicant argues that Bigari fails to disclose retrieving the preapproval amount from a preapproval database on a store controller file server. The Examiner agrees that Bigari fails to disclose retrieving the preapproval amount from a

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preapproval database on a store controller file server. Bigari disclose retrieving the preapproval amount from a voucher.

On page 25, final paragraph, Applicant argues that independent claim 24 directed to a computer readable medium containing a computer program product is allowable for the same reasons Applicant believes claim 1 is allowable. As set forth above, the Examiner believes that claim 1 fails to distinguish over the prior art. Additionally, claim 24 fails to distinguish over the prior art for the same reasons.

On pages 26-28, Applicant traverses the Examiner's assertion of Official Notice. As required by M.P.E.P. 2144.03 C., the Examiner has supplied support for the assertion of Official Notice by supplying a reference teaching the use of historical data to determine credit approval. If the Bigari reference is modified, Applicant argues that Bigari teaches away from dynamically requesting an additional amount for approval during the sales transaction. It appears that Applicant is arguing limitations not found in claims 6, 7, 29, or 30. Claims 6, 7, 29, and 30 do not require "dynamically requesting an additional amount for approval during the sales transaction".

On page 28, second full paragraph, Applicant argues that Bigari teaches away from reauthorization and prevents the modification to include reauthorizations. Again, Applicant is arguing limitations not found in claims 6, 7, 29, or 30. Claims 6, 7, 29, and 30 do not require reauthorization.

Arguments related to the combination of Bigari and Foladare on pages 28-31 are moot because the rejections are withdrawn. Claims 13 and 14 depend from claim 9 and claims 35 and 36 depend from claim 31.

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On page 32, final paragraph, Applicant argues that the Examiner is using improper hindsight by combining Bigari and Trotta. Additionally, Applicant argues that there is no motivation for combining the references. First, in response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). Second, in response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the motivation is clearly set forth in the rejection. As set forth above, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Bigari with promotional display as taught by Trotta, Jr., because the promotional displays valuable shopper specific marketing data which can be sold to manufacturers to subsidize the cost of the technology (see column 7, lines 4-6).

Conclusion

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jim McClellan whose telephone number is (703) 305-0212. The examiner can normally be reached on Monday-Friday from 9:30 to 6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Olszewski, can be reached at (703) 308-5183.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.

Any response to this action should be mailed to:

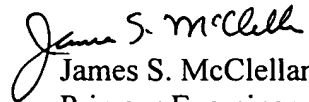
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or faxed to:

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(703) 872/9306 (Official communications) or
(703) 746-3516 (Informal/Draft communications).

Hand delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive,
Arlington, VA, 7th floor receptionist.


James S. McClellan
Primary Examiner
A.U. 3627

jsm
November 25, 2003